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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/388,926	09/02/1999	HIEN D. MA	38910	4658

23820 7590 11/17/2005

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EXAMINER

HEWITT II, CALVIN L

ART UNIT PAPER NUMBER

3621

DATE MAILED: 11/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/388,926

Applicant(s)

MA ET AL.

Examiner

Calvin L. Hewitt II

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Status of Claims

1. Claims 1-20 have been examined.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1, 10 and 13 have been amended to include the language of a receiver for receiving an encrypted broadcast signal comprising data "operable to identify an actual delineation between broadcast segments". Applicant's Specification, on the other hand, recites "broadcast segments" that can be "the duration of a song, the portion between commercials, or any other signal duration t hat can be determined from beginning to end" and recording said broadcast segments using a [player/recorder] processor (Specification, page 5, lines 1-13

and 27-34). Therefore, the receiver does not receive segments that delineate between broadcast segments.

Claims 2-9, 11, 12 and 14-20 are also rejected as they depend from claims 1, 10 or 13.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 10, 13 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The terms "actual delineation" in claims 1, 10, and 13, and "actual" in claim 20, are relative terms which renders the claim indefinite. The terms "actual delineation" and "actual" are not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claims 2-9, 11, 12 and 14-20 are also rejected as they depend from claims 1, 10 or 13.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Payton, U.S. Patent No. 5,790,935 in view of Iwamura, U.S. Patent No. 6,272,535, Park, U.S. Patent No. 5,757,909 and Stepp et al., U.S. Patent No. 6,363,440.

As per claims 1-20, Payton teaches a virtual on-demand digital information delivery system comprising:

- a receiver that receives an encrypted digital signal (audio, video or other) (column 1, lines 15-27; column 4, lines 55-67; column 5, lines 55-67)
- memory for storing an encrypted digital signal (column/line 2/64-3/9; column 6, lines 1-19)
- a recorder for recording onto a recording medium (column 6, lines 20-50; column 8, lines 11-25)
- a recording medium player (figure 5; column 6, lines 20-50; column 8, lines 11-25)
- plurality of recording mediums that record deciphered digital signals (column 6, lines 20-50)

- combined player and recorder (column 6, lines 20-50)
- decryption of encrypted signal (column 6, lines 1-20)
- storing encrypted digital signals in a memory device as it is being received (column 4, lines 55-67; column 6, lines 1-20 and 44-50)

Payton does not explicitly recite a buffer connected to a receiver or determining whether the beginning of a signal is in the buffer and recording the signal if the beginning is present. Stepp et al. teach a signal recording method and apparatus comprising: a buffer connected to a receiver for storing at least a portion of the signal (figure 1; column 1, lines 42-59; column 4, lines 1-32), determining whether the beginning of a signal is present in said buffer and a user recording the signal to a recording medium if the beginning of the desired signal is present (figure 3; column 4, lines 32-56; column 5, lines 1-45). Further, as Stepp et al. teach an information signal that comprises the duration of the signal and start times (column 4, lines 34-38) consecutively broadcast signals will not collide, therefore, the system necessarily delineates between broadcast segments.

However, neither Payton nor Stepp et al. teach payment cards. Iwamura teaches a user terminal for receiving digital content, where the terminal is associated with an accounting apparatus (figure 8). Iwamura also teaches an accounting apparatus that deducts value from a card (e.g. smart, pre-paid, credit, debit... etc.) that stores monetary credits (column 5, lines 24-30; column 6, lines

10-30), determines whether a card has sufficient value and allows a user to add value to the card in order to access data (column/line 5/24-6/37). While Park teaches encryption keys and utilizes smart cards to decrypt digital signals transmitted to a user terminal (column 1, lines 5-26 and 44-55; column 2, lines 31-37; column/line 3/62-4/17; column 4/55-5/5; column 6, lines 29-67; column/line 7/65-8/16; column/line 9/64-10/15; column/line 11/53-12/10; column 13, lines 22-29). Therefore, it would have been obvious to combine the teachings of Payton, Stepp et al., Iwamura, and Park. Payton teaches delivering digital information to users ('935, figure 2). By implementing the system of Payton with the teachings of Stepp et al., users can record, " ... a program in its entirety from the beginning even though the decision to record the program occurs after the program occurs after the program starts and has been broadcast for a non-zero duration. ('440, column 1, lines 11-28)" Payton also teaches user payment for downloaded digital items ('935, column 4, lines 64-67), therefore, it would have been obvious to pay for access using the smart card of Iwamura as he teaches an accounting apparatus using a card to pay for access to digital data ('535, column 1, lines 5-17), such as content that the user decides to record to a medium from a buffer ('440, figure 3; column 4, lines 32-56; column 5, lines 1-45). Payton and Iwamura also teach that digital data should be encrypted to prevent illegal or unauthorized usage ('935, column 4, lines 60-67; '535, column/line 15/24-16/56). Hence, using smart cards to store encryption keys

would lead to increased efficiency as it combines data security ('909, abstract)
with a method for obtaining, or paying, for digital content.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (571) 272-6712.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
c/o Technology Center 2100
Washington, D.C. 20231

or faxed to:

(571) 273-8300 (for formal communications intended for entry and
after-final communications),

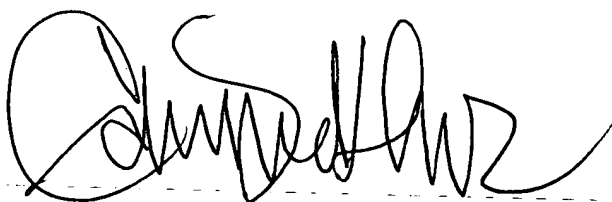
or:

(571) 273-6709 (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

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A handwritten signature in black ink, appearing to read 'Calvin Hewitt II', written over a horizontal dashed line.

Calvin Loyd Hewitt II

November 16, 2005